

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Hubert ELMER et al.

Serial No.: 10/509,822

Filed: September 30, 2004

For: Separating Wall

Examiner: CHAPMAN, J. E.

Group Art: 3635

Commissioner for Patents
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF

SIR:

This is appellants' reply brief in response to the Examiner's Answer mailed January 15, 2009 in accordance with 37 C.F.R. § 41.41. Any fees or charges required in connection with this application may be charged to PTO Deposit Account No. 03-2412.

The Examiner's Answer sets forth new points of argument in Section (10) Response to Argument, to which appellants reply as follows.

(A)

There is no reason that Holmes be combined with WO '019 to arrive at the claimed invention, as is suggested in the Examiner's Answer.

On page 8 of the Examiner's Answer, the Examiner states the following:

The elastic mass is seen as a substitute/addition to the connector halves 10, 15, 22 to provide a water proofing treatment to the panel (emphasis added).

Appellants respectfully disagree based on the following submitted detailed reasons.

(i)

One skilled in the art would not substitute the alleged permanently elastic mass 58 in Holmes for the connector halves 10, 15, 22 in WO '019, because doing so would change the principle of operation employed by WO' 019. Such a substitution was held to be non-obvious in *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). See MPEP § 2143.01VI.

As appellants submitted in the Appeal Brief, WO '019 is conceived to form its connectors as connector halves 10, 15, 22, which are adapted to be inserted into the hole in the glass plate from both sides and are then bolted together. If such connector halves 10, 15, 22 in WO '019 are replaced by the alleged permanently elastic mass 58 taught by Holmes, as is suggested in the Examiner's Answer, the principle of operation of the connectors in WO '019 will be altered. More specifically, the modified art will employ the alleged permanently elastic mass 58, instead of using the connector halves 10, 15, 22 that WO '019 is conceived to provide, to connect the various glass wall 3 and transom window 8 of WO '019. Consequently, the underlying invention concerning the connector halves 10, 15, 22 disclosed in WO '019 will be nullified by such modified art.

Therefore, such proposed modification of WO '019 is neither conceivable by one skilled in the art nor permissible under MPEP § 2143.01VI. Accordingly, it is not obvious substitute Holmes's permanently elastic mass 58 for the connectors in WO '019 to arrive at the invention recited in independent claim 10.

(ii)

One skilled in the art will not add Holmes's alleged permanently elastic mass 58 to the connector halves 10, 15, 22 in WO '019, because doing so will contradict to the explicit teachings of WO '019 and/or render WO '019 unsatisfactory for its intended purpose of eliminating strip-like connectors interconnecting adjacent panels.

The Examiner states that “Holmes is cited to show the elastic mass between the glass panels to directly join the same to one another without the gaps between the panels” (see, page 9 of the Examiner’s Answer). Without admitting or disputing the above interpretation concerning the elastic mass taught by Holmes, appellants submit that such teaching of Holmes cannot be applied to WO ‘019 without considering the conflict teachings in WO ‘019.

WO ‘019 discusses a conventional connecting system, in which plastic plates are interconnected nonpositively and positively by strip-like connectors (see, page 3 of the English translation of WO ‘019). U.S. Patent 5,163,257 is cited in WO ‘019 to illustrate such a conventional connectors, which are adapted to join the longitudinal ends/edges of adjacent panels 32 (see, e.g., Fig. 6 of the ‘257 Patent, copy attached for the Board’s convenient reference). WO ‘019 explicitly teaches that its invention provides to a connector addressing deficiencies in such a conventional system and assuring a sufficient tolerance compensation of among the glass panes.

In view of the above teachings of WO ‘019, one skilled in the art will appreciate that no connectors should be provided inbetween adjacent panels for purpose of connecting such panels. The alleged permanently elastic mass 58 in Holmes is connected to and positioned inbetween adjacent panels. Accordingly, one skilled in the art will appreciate that the alleged permanently elastic mass 58 taught by Holmes is not be used in WO ‘019. Doing otherwise contradicts to the above explicit teachings of WO ‘019.

Moreover, the alleged permanently elastic mass 58 cannot be applied to WO ‘019 because doing so will render WO ‘019 unsatisfactory for its intended purpose of eliminating strip-like connectors interconnecting adjacent panels. See, MPEP § 2143.01V.

In view of all the above, there is no reason that Holmes be combined with WO ‘019 to arrive at the claimed invention, as is suggested in the Examiner’s Answer.

(B)

Even if Holmes is combined with WO '019 as is suggested in the Examiner's Answer, the combined references does show "the transom panel being connected in frictional engagement with the side panels and with the top structure by the permanently elastic mass," as is recited in independent claim 10.

The Examiner's combination merely establishes that the alleged permanently elastic mass 58 in Holmes is inserted between the glass panel units (see, glass panel units 11a, 11b in Fig. 5 of Holmes). As Holmes teaches and the Examiner acknowledges, the alleged permanently elastic mass 58 is employed to produce a glazed exterior butt joint of superior appearance and strength (see, col. 9, ll. 13-15). Holmes thus teaches, at most, the alleged permanently elastic mass 58 being in frictional engagement with glass panel units 11a, 11b.

There is no teaching that Holmes' glass panel units 11a, 11b themselves are connected with each other in frictional engagement, much less through the alleged permanently elastic mass 58, as are the transom panel and the side panels recited in independent claim 10. As stated in appellants previous submissions, the adjacent glass panel units 11a, 11b in Holmes are held together by and joined to a mullion 45. As Holmes explicitly teaches, the alleged permanently elastic mass 58 is inserted in between the glass panel units 11a, 11b after they are mounted onto the mullion 45 and in place (see, col. 9, ln. 7). Because of this direct connection of the glass panel units 11a, 11b by the mullion 45, no frictional engagement can exist between such adjacent glass panel units 11a, 11b in Holmes, either directly or through the alleged permanently elastic mass 58.

In WO '019, the glass panels 3,8 are connected through the connector halves 10, 15, 22. Accordingly, even if the alleged permanently elastic mass 58 is inserted between such glass panels 3, 8, no fictional engagement can be generated therebetween by way of such alleged permanently elastic mass 58 taught by Holmes.

Therefore, the combined references do not teach “the transom panel being connected in frictional engagement with the side panels and with the top structure by the permanently elastic mass,” as recited in independent claim 10.

In light of appellants’ remarks submitted above and in the Appeal Brief, appellants respectfully submit that the teachings of the combined references fail to establish a *prima facie* case of obviousness with regard to independent claim 10. Accordingly, independent claim 10 and its dependent claims 11-14 and 17-21, patentably distinguishes over the cited art. The Final Rejection of the claims should be reversed.

Respectfully submitted,
COHEN PONTANI LIEBERMAN & PAVANE LLP

By / Alfred W. Froebrich /
Alfred W. Froebrich
Reg. No. 38,887
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: March 16, 2009